



PTO/SB/21 (08-00)

**TRANSMITTAL
FORM***(to be used for all correspondence after initial filing)*

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/995,866
	Filing Date	November 26, 2001
	First Named Inventor	Akira MASE
	Group Art Unit	2871
	Examiner Name	H. Nguyen
Total Number of Pages in This Submission	Attorney Docket Number	0756-2401

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosures 1. RCE 2. 3. 4. 5. 6.
Remarks		<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 50-2280 for the above identified docket number.

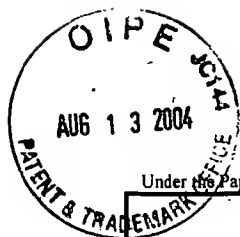
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Eric J. Robinson, Reg. No. 38,285 Robinson Intellectual Property Law Office, P.C. PMB 955 21010 Southbank Street Potomac Falls, VA 20165
Signature	
Date	8-11-04

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PTO/SB/30 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

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**REQUEST
FOR
CONTINUED EXAMINATION (RCE)
TRANSMITTAL**

Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000,
provides for continued examination of an utility or plant application
filed on or after June 8, 1995.
See The American Inventors Protection Act of 1999 (AIPA).

Application Number	09/995,866
Filing Date	November 26, 2001
First Named Inventor	Akira MASE
Group Art Unit	2871
Examiner Name	H. Nguyen
Attorney Docket Number	0756-2401

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

NOTE: 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53(d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000), which established RCE practice.

1. **Submission required under 37 C.F.R. § 1.114**

- a. ☐ Previously submitted
- i. ☐ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on _____
(Any unentered amendment(s) referred to above will be entered).
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
- iii. ☐ Other
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☐ Other

08/13/2004 KBETEM1 00000051 09995866

01 FC:1801
02 FC:1253

770.00 DP
840.00 DP

2. **Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(l) required)
- b. ☒ Other Petition for Extension of Time

3. **Fees** The RCE fee under 37 C.F.R. § 1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed.

- a. ☐ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. _____
- i. ☐ RCE fee required under 37 C.F.R. § 1.17(e)
- ii. ☐ Extension of time fee (37 C.F.R. §§ 1.136 and 1.17)
- iii. ☐ Other _____
- b. ☒ Check in the amount of \$1610.00 enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	Eric J. Robinson	Registration No. (Attorney/Agent)	38,285
Signature		Date	8-11-04

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**FEE TRANSMITTAL
FOR FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant Claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$1610.00)

Complete if Known

Application Number 09/995,866

Filing Date November 26, 2001

First Named Inventor Akira MASE

Examiner Name H. Nguyen

Group Art Unit 2871

Attorney Docket No. 0756-2401

METHOD OF PAYMENT

- 1.
- ☐
- The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number 50-2280

Deposit Account Name Robinson Intellectual Property Law Office

- ☒
- Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17 and credit overpayments

☐ Applicant claims small entity status. See 37 CFR 1.27

- 2.
- ☒
- Payment Enclosed:

☒ Check ☐ Credit Card ☐ Money Order ☐ Other**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$).00

2. EXTRA CLAIM FEES

Total Claims 11 -20** = 0 X \$18 = \$0.00

Independent Claims 4 -4** = 0 X \$86 = \$0.00

Multiple Dependent 0 = \$0.00

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$).00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	465	Extension for reply within third month	\$840.00
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.29(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	\$770.00
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify) _____					

* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$1610.00)

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Name (Print/Type) Eric J. Robinson

Registration No. 38,285
(Attorney/Agent)**Complete (if applicable)**

Telephone (571) 434-6789

Signature *[Signature]*

Date 8-11-04



Attorney Docket No. 0756-2401

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Akira MASE

Serial No. 09/995,866

Filed: November 26, 2001

For: CONDUCTIVE PATTERN

PRODUCING METHOD AND ITS

APPLICATIONS

) Group Art Unit: 2871

) Examiner: H. Nguyen

) CERTIFICATE OF MAILING

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) Commissioner for Patents, P.O. Box 1450,
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) 2004.

Adelle M. Stamps

RESPONSE

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Official Action mailed February 11, 2004, and the Advisory Action mailed July 1, 2004, have been received and their contents carefully noted. A *Request for One Month Extension of Time* was filed June 11, 2004. Filed concurrently herewith is a *Request for Three Month Extension of Time*, which extends the shortened statutory period for response to August 11, 2004. Also, filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statement filed on November 26, 2001.

Claims 2-12 are pending in the present application, of which claims 2, 4, 7 and 10 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 1 of the Final Official Action rejects claims 2 and 3 as obvious based on the combination of U.S. Patent No. 4,385,976 to Schuster-Wolden et al. and U.S. Patent No. 4,462,883 to Hart. Paragraph 2 of the Final Official Action rejects claims 4-

12 as obvious based on the combination of Schuster-Wolden, Hart and U.S. Patent No. 4,680,226 to Takeda. The Applicants respectfully traverse the rejection because the Final Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Advisory Action asserts that "Applicant's ONLY arguments are [as] follows: Hart is not in the field (display device) of Applicant's endeavor" (page 2, Paper No. 0604). This is a mischaracterization and extreme oversimplification of the Applicant's arguments presented in the *Response* mailed June 11, 2004. In summary, arguments regarding the alleged combination of Schuster-Wolden and Hart were presented in the *Response*, as follows:

1. The Final Official Action appears to ignore the recitation of a display device in the preamble.

2. Since Hart is directed to an entirely different field of endeavor from the present invention and Schuster-Wolden, one of skill in the art would not have been motivated to combine the prior art references as asserted in the Final Official Action.

3. The prior art lacks any teaching or suggestion that teaches the desirability of the use of a window glass "anti-reflecting" coating in combination with a connection between a lead and an IC chip of a display device.

4. Takeda does not cure the deficiencies in the motivation to combine Schuster-Wolden and Hart.

5. The Examiner has improperly reversed the burden of proving a *prima facie* case of obviousness; therefore, it is not necessary for the Applicant to show unexpected results.

For at least the reasons stated above, the Official Action has not presented a *prima facie* case of obviousness.

Regarding whether Schuster-Wolden and Hart describe analogous art, the Final Official Action appears to be exactly the same as the previous rejection. In the *Ameridment* filed November 4, 2003, the Applicant argued that Hart is directed to an entirely different field from the present invention and Schuster-Wolden. In response to this argument, the Examiner asserts that the "display device" is considered as a preamble. Specifically, the Final Official Action appears to ignore the recitation of a display device in the preamble. MPEP § 2111.02 discusses the weight of the preamble of a claim as follows:

[A] claim preamble has the import that the claim as a whole suggests for it." Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains

and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.).

Similarly, here, the recitation of "a display device" gives life, meaning and vitality to the claim as a whole. The claims of the present invention are specifically concerned with a display device comprising a glass substrate; a lead formed over the glass substrate, the lead comprising a first layer comprising silver or a first conductive layer and a second layer comprising indium tin oxide formed on the first layer; an IC chip provided over the glass substrate and electrically connected to the lead wherein a pad of the IC chip is electrically connected to the second layer of the lead. Further, the Applicant respectfully submits that the inclusion of a display device in the preamble is essential to point out the invention defined by the claims. Accordingly, the preamble of the claims of the present invention cannot be properly dismissed when evaluating the scope of the claims.

The Advisory Action argues that the claim body recites "a lead comprising a second layer (ITO) formed on a first layer (silver), which can be not used ONLY for display device" (page 2, Paper No. 0604). Therefore, it appears that the Advisory Action continues to ignore the preamble.

Furthermore, MPEP § 2141.01(a) provides the following guidance regarding the importance of analogous prior art in a *prima facie* case of obviousness:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

The Official Action has not shown that Hart is in the field of applicant's endeavor or that Hart is reasonably pertinent to the particular problem with which the Applicant is concerned. The Applicant respectfully submits that a low emissivity coating for window glass (Hart) is not reasonably pertinent to Schuster-Wolden or the present invention.

Even if "display device" in the preamble does not give life, meaning and vitality to the claim as a whole, the Examiner still fails to address the issue that Hart is directed to an entirely different field of endeavor from the present invention and Schuster-Wolden, and therefore one of skill in the art would not have been motivated to combine the references as asserted in the Final Official Action. It is noted that this argument is not the same as merely arguing that prior art references are in a different field of endeavor.

Specifically, Hart is directed to low emissivity coatings, particularly coatings for window glass (col. 2, lines 5-9 and 51-54), which are entirely irrelevant to a lead to be electrically connected to an IC. Consequently, Hart is not in the field of the Applicant's endeavor, is not reasonably pertinent to the particular problem with which the inventor is concerned, and would not have logically commended itself to an inventor's attention in considering the problem (see MPEP § 2141.01(a)). Therefore, the Applicant respectfully submits that the Final Official Action has not provided a proper suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Schuster-Wolden and Hart or to combine reference teachings to achieve the claimed invention.

Despite the above arguments, the Applicant respectfully submits that the Examiner fails to establish a *prima facie* case of obviousness. The Final Official Action asserts that the combination is "for anti-reflecting" (page 3, Paper No. 0104). The Applicants respectfully disagree and traverse the above assertion in the Final Official Action. Although Hart appears to describe an "anti-reflection metal oxide coating" for window glass, the prior art lacks any teaching or suggestion that teaches the desirability of the use of such a window glass "anti-reflecting" coating in a connection between a lead and an IC chip of a display device. Schuster-Wolden and Hart, either alone or in

combination, do not teach or suggest why one of ordinary skill in the art would have been motivated to add to the device of Schuster-Wolden a lead comprising a first layer comprising silver or a first conductive layer and a second layer comprising indium tin oxide formed on the first layer; and then further modify the alleged combination such that an IC chip is provided over a glass substrate and electrically connected to the lead where a pad of the IC chip is electrically connected to the second layer of the lead, as claimed in the independent claims of the present invention.

Takeda does not cure the deficiencies in the motivation to combine Schuster-Wolden and Hart. The Final Official Action relies on Takeda to allegedly teach the features of an adhesive (page 4, *Id.*). Takeda does not show that Hart is in the field of the Applicant's endeavor, is reasonably pertinent to the particular problem with which the inventor is concerned, or would have logically commended itself to an inventor's attention in considering the problem.

Further, the Final Official Action asserts that "the specification does not disclose the unexpected result or motivation (why it is important) of a lead comprising a second indium-tin-oxide layer formed on the first silver layer" (page 4, Paper No. 0104). The Applicant respectfully submits that the Examiner has improperly reversed the burden of proving a *prima facie* case of obviousness; therefore, it is not necessary for the Applicant to show unexpected results. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Final Official Action has failed to carry this burden. While the Final Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Final Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the present invention.

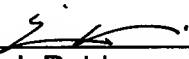
In the present application, it is respectfully submitted that the prior art of record, alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the

artisan would have found the claimed invention to have been obvious in light of the teachings of the references. Specifically, the Official Action has not presented a convincing line of reasoning as to why the artisan would have combined a solderable layer system (Schuster-Wolden) with a low emissivity coating on window glass (Hart) and how such a combination would result in or be applied to a display device, as required by the independent claims of the present invention.

For the reasons stated above, the Final Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789